

REMARKS

Claims 1-29 are pending in the present application. Claims 1-8, 10-14 and 16-29 stand rejected. Claims 9 and 15 stand objected to.

Telephonic Examiner Interview

Applicants' representative conducted a telephonic interview with examiner on March 18, 2009 and discussed claim 1. No agreement was reached.

Claim Objections

The examiner objects to the word "ales" in claim 9. Applicants have amended it to read "files." The examiner objects to the claim 15 recitation of "change the date of autodeletion of the file." Applicants have amended the limitation to read "change a date of autodeletion of the file." Applicants respectfully submit that these amendments overcome the present objections.

Claim Rejections – 35 USC § 112

Claim 13 stands rejected because the examiner states, "it is unclear how a software program could physically mail a paper document to a third party." Applicants have amended the claim to clarify in the interest of expediting prosecution, but respectfully disagree. It is inherent that a software program executes on hardware. It is common for a hardware computer to be connected to a printer to print electronic files in physical form. Further, mechanical and/or computer systems for producing stamped letters and introducing those letters into a postal mail system are known.

That being said, applicants have amended the claim to read "...specification instructs the command executor to print the file at a printer, and to instruct a mailing component to insert the printed file into a postal mail system." Applicants respectfully submit that this overcomes the rejection.

Claim Rejections – 35 USC § 102

Claims 1-4, 6, 17, 18-19 and 25 stand rejected under 34 USC 102(e) as being anticipated by Karim (Pat. No. 6,654,892).

Claim 1 recites the limitation, “a mail processor configured to produce a stripped electronic mail item by removing the file from the first electronic mail item and replacing it with a corresponding file handle.” The examiner states that this is taught by Karim at col. 8, line 57: “the command is obtained from the client e-mail at block 706 and the associated file name is obtained at block 708.”

Applicants respectfully disagree. The present limitation recites taking the electronic mail item and altering it to produce a stripped electronic mail item. However, the reference discloses simply parsing the received email to determine things such as source and destination addresses, a command, and a associated file name. This act of parsing as disclosed by Karim does not modify the electronic mail item in any way, so no stripped electronic mail item is produced.

Claim 1 also recites the limitation, “a mail deliverer configured to send the stripped electronic mail item to the recipient.” The examiner states that this is taught by Karim at col. 7, line 22: “where the client code control command is a check out command, the content of the file being checked out of the source code control system may be provided as an attachment file.”

Applicants respectfully disagree. As discussed *supra*, Karim does not disclose a stripped electronic mail item. The “acknowledgment e-mail” disclosed by Karim lacks the claimed connection with the original email item (in the present application, “a first electronic mail item;” in Karim, “an e-mail”) because that acknowledgment is sent only in response to the e-mail, whereas the stripped electronic mail item of the present application is a directly modified form of the first electronic mail item, modified by “removing the file from the first electronic mail item and replacing it with a corresponding file handle.”

Further, applicants respectfully submit that examiner is combining portions of the reference in ways not supported by the reference. A Karim email that has a “check in” command includes a file attachment. A Karim email that has a “check out” command

includes a file handle. Those two distinct emails are part of two distinct transactions and are sent from the same source – the remote user that wishes to access the version control system. One user does not send an e-mail containing a file, resulting in a second user receiving that e-mail stripped of the file, which is replaced by a file handle. The first user either sends an e-mail containing a file, or the user sends an e-mail containing a file handle, and that first user receives whatever result of that e-mail he has sent.

Still further, applicants respectfully submit that examiner's claim construction requires the sender and the recipient to be the same. However, this does not make sense in the context of the claim. If the sender and the recipient were the same, then there would be no need to send the stripped electronic mail item to the recipient, since the recipient would already have the file that is referenced by the file handle of the stripped electronic mail item.

Further supporting this construction is that different terms are used for these different things: "sender" and "recipient." If they meant the same thing, then one of the terms would be superfluous (*See Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841, 848 (CAFC 2006), "Where the terms 'engaging' and 'sealing' are both expressly recited in a patent claim, 'engaging' cannot mean the same thing as 'sealing'; if it did, one of the terms would be superfluous.). Therefore these two distinct terms within a single claim are to be construed to refer to distinct things.

Claim 1 also recites the limitation, "a second receiving portal configured to receive, from the recipient, *a second electronic mail item including* a first field which contains a user identification, *a second field which contains the file handle*, and a third field which contains a command specification, without prompting for the email item." The examiner states that this is taught by Karim at col. 8, line 57: "the command is obtained from the client e-mail at block 706 and the associated file name is obtained at block 708."

Applicants respectfully disagree. Examiner has used this same portion of the reference to state that Karim teaches the claimed "a mail processor configured to produce a stripped electronic mail item by removing the file from the first electronic mail item and replacing it with a corresponding file handle." As per above, the claimed stripped electronic mail item and second electronic mail item are to be construed as being distinct things. Therefore, applicants respectfully submit that the single e-mail in this portion of the reference cannot teach both the above claimed "stripped electronic mail item" and the here

claimed “second electronic mail item.” Further, as the Karim reference discloses only a single user (in addition to the system itself) sending e-mail, it cannot disclose both a sender and a recipient (in addition to the system itself) sending e-mail as is claimed here.

Claim 1 also recites the limitation, “a rights verifier configured to determine whether the recipient has privilege to access the stored file corresponding to said file handle.” The examiner states that this is taught by Karim at col. 6, line 40: “if it is determined at block 504 that the password is invalid, the e-mail is ignored.”

Applicants respectfully disagree. The present claim recites a per-file access privilege, while Karim discloses only a source code control system-wide access privilege, and does not disclose the smaller granularity of making the privilege on a per-file basis. See Karim at col. 6, lines 35-6: “...a password may be used to indicate those e-mails that are to be processed by the source code control system,” which discloses only that the Karim password pertains access to the source code control system as a whole.

For at least these reasons, applicants respectfully submit that claim 1 is in condition for allowance.

Independent claims 18, 19 and 25 recite similar limitations as claim 1. Applicants respectfully submit that claims 18, 19, and 25 are in condition for allowance for reasons similar to why claim 1 is in condition for allowance.

Claim 3 recites the limitation, “a user identification system which extracts information from the electronic mail item including the from address, destination address, the subject, the reply-to, and the body of the electronic mail item, to enable verification of the sender as a known user of the system.” Examiner states that this is taught by Karim at Fig. 2 and col. 4 line 55: “The present invention preferably handles only those e-mails that are addressed to the source code control system of the present invention. It is therefore desirable to implement a password or identifier code that may be used to designate those e-mails that are addressed to the source code control system.”

Applicants respectfully disagree. The reference discloses only using a password or identifier code to determine that the sender is a known user of the system. However, the claim recites using the from address, the destination address, the subject, the reply-to and the body of the electronic mail item. For instance, the from address may not reasonably be

construed to be a password since it is commonly publicly visible and a tenet of password policy is that passwords are kept private. The same applies to such fields as the destination address and the reply-to.

For at least these reasons, as well as because it depends from claim 1 which is in condition for allowance, applicants respectfully submit that claim 3 is in condition for allowance.

Applicants respectfully submit that dependent claims 2, 4, 6 and 17 are in condition for allowance for at least the reasons that independent claim 1 is in condition for allowance.

Claim Rejections – 35 USC § 103

Claims 5, 7, 9 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Karim, in view of Boaz et al. (U.S. 5,333,266). Applicants respectfully submit that dependent claims 5, 7, 9 and 10 are in condition for allowance for at least the reasons that independent claim 1 is in condition for allowance.

Claims 11 and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Karim, in view of Pearl et al. (US 200210083035). Applicants respectfully submit that dependent claims 11 and 16 are in condition for allowance for at least the reasons that independent claim 1 is in condition for allowance.

Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Karim in view of Boaz, in view of Tverskoy et al. (US 2001 10043678). Applicants respectfully submit that dependent claim 12 is in condition for allowance for at least the reasons that independent claim 1 is in condition for allowance.

Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Karim in view of Boaz, in view of Martin (US 6,432,232). Applicants respectfully submit that dependent claim 13 is in condition for allowance for at least the reasons that independent claim 1 is in condition for allowance.

Claims 14 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Karim in view of Boaz, in view of Ryan et al. Applicants respectfully submit that dependent

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claims 14 and 15 are in condition for allowance for at least the reasons that independent claim 1 is in condition for allowance.

Claims 8, 21, 24, 27 and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Karim. Applicants respectfully submit that dependent claims 8, 21, 24, 27, and 29 are in condition for allowance for at least the reasons that independent claims 1, 19 and 25 are in condition for allowance.

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